

-Remarks-

Entry of the above amendments and reconsideration and withdrawal of the rejection of the claims remaining in the application, i.e., Claims 8 and 9 and the objection to Claims 10 and 11 is respectfully requested. All amendments have been made without waiver or prejudice. Applicants reserve the right to file continuation and/or divisional applications directed to any canceled or other unclaimed subject matter of this application.

Applicants gratefully acknowledge the reminder regarding U.S. Patent Rules of Deposit provided by the Examiner in the Office Action sent February 21, 2008. Applicants submit that ATCC 46829 is currently available from ATCC, P.O. Box 1549, Manassas, VA, 20108. Applicants will ensure that the strain used in this invention is properly deposited in accordance with 37 C.F.R. §§1.801 – 1.809 prior to issuance so that Applicants can guarantee accessibility for the duration of the patent.

The 37 C.F.R. §1.75(c) objection.

The Examiner has objected to Claims 10 and 11, alleging that one or both of those claims is in improper form because a multiple dependent claim cannot be dependent upon another multiple dependent claim. While neither claim 10 nor claim 11 as originally filed was multiply dependent upon another multiply dependent claim, Applicants have amended Claim 10 such that it is now only dependent upon Claim 9. There are now no multiple dependent claims in the application. Applicants submit that this objection is now moot and Applicants respectfully request that the Examiner reconsider and withdraw the 37 C.F.R. §1.75(c) objection to Claims 10 and 11.

The 35 U.S.C. §102(b) rejection.

The Examiner has rejected Claims 1 and 2 as being anticipated by Capek et al. (Capek), which the Examiner alleges teaches the conversion of Formula I to Formula II. The Examiner refers to page 253 of Capek. Applicants have canceled Claims 1 and 2, thus rendering this rejection moot.

The 35 U.S.C. §103(a) rejection.

The Examiner has rejected Claims 1-9 as being unpatentable over Capek in view of US 5,827,706 (Leitner). The Examiner alleges that Capek teaches the conversion of the Compound of Formula I to the Compound of Formula II by the use of *Fusarium solani* strains. The Examiner further alleges that Leitner teaches that the instant strain ATCC 46829 is known in the art. Applicants respectfully traverse.

Capek teaches the use of various strains of *Fusarium* species microorganisms for the transformation of steroids. In particular, Capek teaches the use of *Fusarium solani* to transform Δ^4 -androstene-3,17-dione (i.e., 4-androsten-3,17-dione) to testolactone and Δ^1 -dehydrotestolactone (i.e., 17 α -oxo-*D*-homo-1,4-androstadiene-3,17-dione). Capek teaches this conversion at a concentration of 10 mg substrate to 2 ml ethanol, i.e., corresponding to a concentration of 5 g/L. No other specific concentration or concentration range was disclosed in Capek.

Leitner teaches a nucleotide sequence which codes for an enzyme possessing cyclosporin synthetase-like activity. The nucleotide sequence taught by Leitner is a gene from *Tolypocladium niveum*. The only mention of *Fusarium solani* ATCC 46829 in Leitner occurs in Example 16, column 15, lines 58-60, which states: "DNA from

Fusarium solani ATCC 46829 also displays bands at 3.6 kb, 3.4 kb, 1.9 kb and 0.7 kb together with a further band at approximately 2.1 kb." Applicants fail to understand what Leitner has to do, if anything, with the instant invention. All that Leitner states about *Fusarium solani* is that it has hybridising bands which are similar to those of *Tolypocladium niveum*. A person of ordinary skill in the art employing ordinary creativity and common sense would not be motivated to combine the teachings of Capek with anything taught in Leitner. The Examiner has pointed out that under KSR there is no requirement to use the TSM approach to obviousness rejections. However, Applicants submit the Examiner must show some nexus between the references cited for there to be a rationale to combine the references.

Further, a combination of the references does not result in the instant invention. Applicants have amended the claims hereinabove so that the concentration range is limited to 50 g/L to 70g/L. The only concentration range taught in Capek is 5 g/L. The high concentration ranges employed in the claims of the instant invention are not contemplated by the quite dilute, by comparison, concentration disclosed by Capek. No concentration is taught in Leitner as Leitner is completely irrelevant to the instant invention. Accordingly, based upon the teachings of Capek and/or of Capek in combination with Leitner (which contributes nothing), a person of ordinary skill in the art employing ordinary creativity would not be motivated to attempt the transformation of the instant invention using such a concentrated solution. Applicants respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. §103(a) rejection of claims 8 and 9.

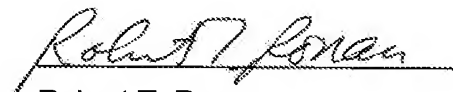
-Conclusion-

Applicants, having responded to all points and concerns raised by the Examiner, believe this application to be in condition for allowance. An early and favorable action is respectfully requested.

Respectfully submitted,

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